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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,696	12/20/2001	Missy L. Villapudua	020375-003100US	4166
20350	7590	05/19/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			WOO, RICHARD SUKYOON	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/027,696

Applicant(s)

VILLAPUDUA, MISSY L.

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10, 13-16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

- 1) Applicant's amendment filed on February 27, 2004 is acknowledged.
- 2) Applicant's arguments with respect to claims 1 and 13 have been considered but are moot in view of the new ground(s) of rejection. The new ground of rejections has been necessitated by the newly added limitation(s), "wherein the payment instrument further includes consumer account information necessary to tie a debit or credit payment transaction to a consumer account" and "the consumer account information is read to provide payment to a merchant".
- 3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

- 4) Claims 1-2, 4-10, 13-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Flasherty et al. (US 2001/0011247 A1) in view of Infosino (US 6,715,679).

#### **W.R.T. Claim 1:**

O'Flasherty et al. discloses a method for protecting consumer personal data, comprising:

receiving an application for a payment instrument (e.g. smart card or loyalty card), wherein the application comprises personal data and a privacy preference of a consumer (see paragraph 0039; see Fig. 5);

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saving the application in a database (see Figs. 1 and 5); and  
storing at least some of the personal data and the privacy preference onto the payment instrument (see Claims, and Fig. 6 and the description thereof).

However, O'Flasherty et al. does not expressly disclose the method, wherein the payment instrument further includes consumer account information necessary to tie a debit or credit payment transaction to a consumer account.

Infosino teaches, for a credit card sized smart or universal card, that the smart card includes consumer account information necessary to tie a debit or credit payment transaction to a consumer account (see Figs., abstract, and Claims).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art, to incorporate Infosino's smart card, which includes consumer account information, into the smart card of O'Flasherty, as taught by Infosino, for the purpose of providing a card holder with the universal card that can be transformed into one or more of any other card (debit, credit and so forth) authorized for use by the holder, and that includes memory for storing multiple consumer account data.

W.R.T. Claims 2 and 4: The modified O'Flasherty et al. also discloses the method, wherein the payment instrument comprises a credit or debit card having a magnetic

stripe, or a processor and memory (smart card) (see Claims and Figs. of both O'Flasherty et al. and Infosino);

W.R.T. Claim 5: The modified O'Flasherty et al. also discloses the method including the step of reading the personal data and the preference at a merchant location when the consumer's payment instrument is accessed, and saving the data at the merchant storage location (see [0039]-[0040] of O'Flasherty et al., for example);

W.R.T. Claim 6: The modified O'Flasherty et al. also discloses the method including the step of mailing marketing material to the consumer only if permitted by the consumer's privacy preference (see paragraph [0040] and claims of O'Flasherty et al.);

W.R.T. Claims 7-8: The modified O'Flasherty et al. also discloses the method, wherein the privacy preference indicates that consumer receives marketing material only from affiliated merchants (*Id.*);

W.R.T. Claim 9: The modified O'Flasherty et al. also discloses the method, wherein the privacy preference indicates that consumer receives marketing material only from the affiliated bank (*Id.*); and

W.R.T. Claim 10: The modified O'Flasherty et al. also discloses the method, wherein the privacy preference indicates that the consumer opts out (see Supra).

**W.R.T. Claim 13:**

O'Flasherty et al. discloses a method for protecting consumer personal data, comprising:

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providing the consumer with a payment instrument (smart card) having stored thereon a privacy preference;

reading the privacy preference from the payment instrument when making a purchase at a merchant location (see generally claims and supra Claim 1);

saving the application in a database (*Id.*); and

contacting the consumer in accordance with the privacy preference (see Fig. 1 and the description thereof).

However, O'Flasherty et al. does not expressly disclose the method, wherein the payment instrument further includes consumer account information necessary to tie a debit or credit payment transaction to a consumer account and the consumer account information is read to provide payment to a merchant.

Infosino teaches, for a credit card sized smart or universal card, that the smart card includes consumer account information necessary to tie a debit or credit payment transaction to a consumer account and the consumer account information is read to provide payment to a merchant (see Figs., abstract, and Claims).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art, to incorporate Infosino's smart card, which includes consumer account information, into the smart card of O'Flasherty, as taught by Infosino, for the purpose of providing a card holder with the universal card that can be

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transformed into one or more of any other card (debit, credit and so forth) authorized for use by the holder, and that includes memory for storing multiple consumer account data so as to provide payment to a merchant.

W.R.T. Claims 14 and 16: The modified O'Flasherty et al. also discloses the method, wherein the payment instrument comprises a credit or debit card having a magnetic stripe, or a processor and memory (smart card) (see Claims and Figs. of both O'Flasherty et al. and Infosino).

5) Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Flasherty et al. and Infosino as applied to claims 1 and 13 above, and further in view of Pollin (US 5,727,249).

The modified O'Flasherty et al. discloses the method for protecting consumer personal data as recited above, but does not specifically disclose that the payment instrument is a check.

Pollin teaches, for a system and method for protecting the consumer personal data, that the method comprises:

utilizing the check as the payment instrument; and  
storing the secure information onto the printed MICR on the check.

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Since Pollin and the modified O'Flasherty et al. are both from the same field of endeavor, the purpose disclosed by Pollin would have been well recognized in the pertinent field of the modified O'Flasherty et al..

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to utilize the check as the well known payment instrument, as taught by Pollin, for the purpose of storing the preference data onto the check's printed MICR as well known payment instrument.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

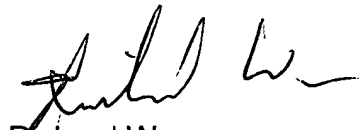


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo  
GAU 3629  
May 14, 2004



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
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